

Page 12  
Serial No. 10/662,599  
Response to Official Action

**In the Drawings**

There are no amendments to the drawings.

**Remarks**

Applicant has amended Claim 19. Applicant respectfully submits that no new matter was added by the amendment, as all of the amended matter was either previously illustrated or described in the drawings, written specification and/or claims of the present application (See, pars. 41-44 & 82-84). Entry of the amendment and favorable consideration thereof is earnestly requested.

As amended, Claim 19 requires among other limitations, said medical video instrument inserted into a body cavity and generating an image stream representative of the body cavity and displayed on said touch screen. Applicant respectfully submits that these limitations are not disclosed or taught in U.S. Patent No. 6,411,851 ("Winkler").

Winkler does not disclose a medical video instrument that generates an image stream representative of the body cavity for display on a touch screen. Rather, Winkler discloses a "magnetic programming head 218" that is configured to assist in programming IMD 10, which may comprise "implantable cardiac pacemakers." (Col. 1, line 8; Col. 4, lines 66-67; Col. 12, lines 54-56 & 66.) Therefore, Winkler can not anticipate Claim 19. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) ("a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.")

The system disclosed in Winkler does not teach or suggest generation of an image stream representative of the body cavity for display on a touch screen. Rather, Winkler teaches that the touch screen is a programming interface for the user to program the IMD.

It is well settled that the mere fact that references can be modified does not render the resultant modification obvious unless the prior art also suggests the desirability of the modification. See, e.g., MPEP 2143.01; *In re Mills*, 916 F.2d 680, 682, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990) (fact that prior art “may be capable of being modified to run the way the apparatus is claimed, there must be some suggestion or motivation in the reference to do so.”). In the present case, Applicant respectfully submits that Winkler does not even hint at generation of an image stream representative of the body cavity and displayed on either the touch screen or on any other screen.

Applicant further submits that if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). In the present case, Applicant respectfully submits that the intended purpose of the IMD taught in the '851 patent is to regulate a vital body function, while the programming apparatus 200 allows a user to program the IMD by means of programming head 218. Modification of the IMD to instead provide a video feed to a physician performing a surgical procedure would destroy the purpose of the IMD. In addition, it is not clear whether Winkler could even be modified to provide both

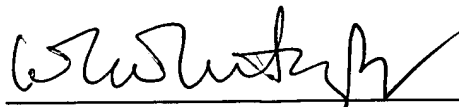
programming functionality and generation of an image stream as the magnetic field emitted by the magnetic programming head would, in all likelihood, prevent an imaging device from functioning properly. Accordingly, such a modification according to presently pending Claim 19 cannot be obvious.

Accordingly, Applicant submits that because Winkler fails to teach or suggest a medical video instrument inserted into a body cavity and generating an image stream representative of the body cavity and displayed on said touch screen as required by all the claims, the pending claims cannot be obvious in view of Winkler. Applicant further submits that modification of Winkler to provide image generation capability would render Winkler unsatisfactory for its intended purpose and therefore cannot be obvious.

It is respectfully submitted that claims 19-31 and 46-48, all of the claims remaining in the application, are in order for allowance and early notice to that effect is respectfully requested.

Respectfully submitted,

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